

Appl. No. : 09/519,829
Filed : March 6, 2000
Office Action Date : May 24, 2004

REMARKS

The foregoing amendment and the following remarks are response to the May 24, 2004 Office Action. Claims 28-53 are pending in the application. In the Office Action, the Examiner rejects Claims 28-53. The Examiner also objects to Claim 53. Applicants have amended Claims 37 and 53 herein.

Applicants respectfully request reconsideration of the application in view of the following remarks.

Response to the Claim Objections

In the Office Action, the Examiner objects to Claim 53 as being dependent on non-existent Claim 59. Applicants thank the Examiner for his careful examination of the present application and submit that the discrepancy in Claim 59 is a typographical error. Accordingly, Applicants have amended Claim 59 herein to depend from Claim 50, as was originally recited.

Rejection of Claims 28-31 and 43-53 Under 35 U.S.C. § 102(b)

In the Office Action, the Examiner rejects Claims 28-31 and 43-53 under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 5,323,146 to Glaschick ("Glaschick"). Applicants respectfully traverse the rejection for the following reasons.

A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. *Verdegaal Brothers v. Union Oil Co. of California*, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). The identical invention must be shown in as complete detail as is contained in the claim. *Richardson v. Suzuki Motor Co.*, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). As discussed below, Glaschick does not expressly or inherently disclose or suggest each and every element of independent Claims 28, 43 and 50.

According to the Examiner, Glaschick discloses a system wherein a user communicates with a computer system using a personal communication device. See page 3 of the present Office Action. Applicants respectfully disagree. FIGS. 1 and 2 of Glaschick show a user 10 accessing a computer 14 through a data station 16 connected thereto. In a one-time procedure

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(i.e., password announcement), the user 10 stores a password in a confidential file 12 of the computer 14. "If the user subsequently wants to call up a service of the computer 14 **over one of the data stations connected with it** his connection privilege is examined (authentication)." Column 4, lines 12-15 (emphasis added). Thus, the data station 16 is a connected terminal of the overall system and is not a personal communication device.

Unlike the invention defined in Claim 28, Glaschick does not disclose, teach or suggest *[a] method of authenticating a user, the method comprising: associating the user with a personal communication device possessed by the user; generating a new password based at least upon a token and a passcode, wherein the token is not known to the user and wherein the passcode is known to the user; setting a password associated with the user to be the new password; transmitting the token to the personal communication device; and receiving the password from the user.* Rather, Glaschick is silent on using a personal communication device possessed by a user. Accordingly, Applicants respectfully submit that Claim 28 is patentably distinguished over Glaschick. Applicants respectfully request the Examiner to withdraw the rejection of Claim 28 under 35 U.S.C. § 102(b) and to pass Claim 28 to allowance.

Claims 29-31 depend from Claim 28 and further define the invention defined in Claim 28. In view of the allowability of Claim 28 and in further view of the limitations in Claims 29-31, Applicants respectfully submit that Claims 29-31 are also patentably distinguished over Glaschick. Applicants respectfully request the Examiner to withdraw the rejection of Claims 29-31.

Unlike the invention defined in Claim 43, the combined references also do not teach or suggest *[a] method of regulating access to a secure system, the method comprising: receiving a request for a token, wherein the request is transmitted from a personal communication device as a result of an action by a user; in response to the receipt of the request, transmitting the token to the personal communication device; receiving login data from the user in response to a request for authentication information, wherein the login data is based at least upon the token; and granting access to the secure system based at least upon the received login data.* Thus,

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Applicants respectfully submit that Claim 43 is patentably distinguished over Glaschick and respectfully request the Examiner to withdraw the rejection of Claim 43.

Claims 44-49 depend from Claim 43 and further define the invention defined in Claim 43. In view of the allowability of Claim 43 and in further view of the limitations in Claims 44-49, Applicants respectfully submit that Claims 44-49 are also patentably distinguished over Glaschick. Applicants respectfully request the Examiner to withdraw the rejection of Claims 44-49.

Unlike the invention defined in Claim 50, the combined references also do not teach or suggest *[a]n access control system comprising: a communication module configured to receive a request for a token, wherein the request is **transmitted from a personal communication device** as a result of an action by a user, and wherein the communication module is further configured to **transmit the token to the personal communication device** in response to the request; a user token server configured to generate a valid password based at least upon the token; and an authentication module configured to receive a submitted password in response to a request for authentication of the user, the authentication module further configured to grant access to the user if at least the submitted password matches the valid password.* Accordingly, Applicants respectfully submit that Claim 50 is patentably distinguished over Glaschick respectfully request the Examiner to withdraw the rejection of Claim 50.

Claims 51-53 depend from Claim 50 and further define the invention defined in Claim 50. In view of the allowability of Claim 50 and in further view of the limitations in Claims 51-53, Applicants respectfully submit that Claims 51-53 are also patentably distinguished over Glaschick. Applicants respectfully request the Examiner to withdraw the rejection of Claims 51-53.

Rejection of Claims 37-39 Under 35 U.S.C. § 102(e)

In the Office Action, the Examiner rejects Claims 37-39 under 35 U.S.C. §102(e) as being anticipated by U.S. Patent No. 6,226,364 to O'Neil ("O'Neil"). Applicants respectfully traverse this rejection for the following reasons.

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O'Neil teaches using a prepaid phone card to allow a user to make a cellular telephone call. The user deposits the face value of the prepaid phone card into an account by entering the serial number printed on the prepaid phone card. The account is associated with a directory number. See column 20, lines 42-62. During subsequent cellular phone calls, the system taught by O'Neil tracks the charges to the prepaid balance in the account and determines when the prepaid balance becomes exhausted. See column 21, lines 50-67. However, Applicants respectfully submit that the prepaid phone card billing and tracking system taught by O'Neil is unrelated to any of the claims in the present application.

Unlike Claim 37 as amended herein, O'Neil does not teach or suggest *[a] method of regulating access to a secure system, the method comprising: associating a user with a personal communication device possessed by the user; associating the user with an account, wherein an initiation of access directly to the secure system through the account requires that the account be activated, receiving a request transmitted by the personal communication device, and in response to the receipt of the request, activating the account.* Rather, O'Neil teaches accessing cellular phone service through a cellular phone. In contrast to O'Neil, Claim 37 teaches receiving a request transmitted by a personal communication device to initiate access **directly** to the secure system (i.e., not through the personal communication device). Therefore, O'Neil does not teach each and every element of the invention defined in Claim 37 as required to anticipate Claim 37 under 35 U.S.C. § 102(e). Accordingly, Applicants respectfully submit that Claim 37 is patentably distinguished over O'Neil. Applicants respectfully request the Examiner to withdraw the rejection of Claim 37 under 35 U.S.C. § 102(e) and to pass Claim 37 to allowance.

Claims 38 and 39 depend from Claim 37 and further define the invention defined in Claim 37. In view of the allowability of Claim 37 and in further view of the limitations in Claims 38 and 39, Applicants respectfully submit that Claims 38 and 39 are also allowable. Applicants respectfully request that the Examiner to withdraw the rejection of Claims 38 and 39 under 35 U.S.C. § 102(e) and to pass Claims 38 and 39 to allowance.

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Rejection of Claims 32-36 and 40-42 Under 35 U.S.C. § 103(a)

In the Office Action, the Examiner rejects Claims 32-36 and 40-42 under 35 U.S.C. § 103(a) as being unpatentable over O'Neil in view of Glaschick. Applicants respectfully traverse this rejection for the following reasons.

Section 2143 of the M.P.E.P. states that to establish *prima facie* obviousness three requirements must be met:

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on the Applicant's disclosure.

Applicants respectfully submit that the elements for a *prima facie* case of obviousness are not met by the proposed combination of O'Neil and Glaschick. Specifically, there is no suggestion or motivation to combine the references, and the references (either individually or when combined) do not teach or suggest all the claim limitations.

There is no suggestion or motivation in the references to combine the teachings of O'Neil and Glaschick. As discussed above, Glaschick teaches a method of authenticating a user of a data station connected to a computer system by exchanging information between the data station and the computer system. However, Glaschick does not suggest a need for using a personal communications device as part of its system. Further, the prepaid telephone card billing and tracking system taught by O'Neil is completely unrelated to the subject matter taught in Glaschick. While, as the Examiner points out, O'Neil teaches receiving a unique serial number and barcode as printed on the prepaid phone card in order to prevent dissemination of counterfeit cards and card information (see column 17, lines 15-22), O'Neil does not suggest or provide any

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motivation for implementing the elaborate authentication system in Glaschick including multiple exchanges of hashed passwords. O'Neil does not even suggest a need for additional security measures.

Rather, it appears that the Examiner has impermissibly used hindsight derived from the teachings in the present application, and not the teachings in the prior art. See In re Dembiczak, 175 F.3d 994, 999 (Fed. Cir. 1999) (holding the Board impermissibly used hindsight in determining obviousness). In Dembiczak, the Federal Circuit reiterated that a determination of obviousness cannot simply rely on the inventor's disclosure as a "blueprint" without evidence of a suggestion, teaching or motivation in the prior art. Id. Thus, there is not a *prima facie* case of obviousness.

Even if O'Neil and Glaschick were to be combined, which they cannot be, they would not teach or suggest each claim limitation of independent Claim 34. Unlike the invention defined in Claim 34, the combined references do not teach or suggest *[a] user authentication system comprising: a user database configured to associate a user with a personal communication device possessed by the user; a control module configured to create a new password based at least upon a token and a passcode, wherein the token is not known to the user and wherein the passcode is known to the user, the control module further configured to set a password associated with the user to be the new password; a communication module configured to transmit the token to the personal communication device; and an authentication module configured to receive the password from the user.* Rather, both O'Neil and Glaschick are silent as to the subject matter of Claim 34. Thus, the invention defined in Claim 34 is not obvious in view of the proposed combination. Applicants respectfully submit that Claim 34 is patentably distinguished over O'Neil in view of Glaschick. Applicants respectfully request the Examiner to withdraw the rejection of Claim 34 under 35 U.S.C. § 103(a) and to pass Claim 34 to allowance.

Claims 35 and 36 depend from Claim 34 and further define the invention defined in Claim 34. As discussed above, Claims 32-33 and 40-42 also depend from allowable independent claims. In view of the allowability of the respective independent claims and in further view of

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the limitations in Claims 32-33, 35-36 and 40-42, Applicants respectfully submit that Claims 32-33, 35-36 and 40-42 are also patentably distinguished over the cited references. Therefore, Applicants respectfully submit that Claims 32-33, 35-36 and 40-42 are also allowable. Applicants respectfully request the Examiner to withdraw the rejection of Claims 32-33, 35-36 and 40-42 under 35 U.S.C. § 103(a).

Summary

In view of the foregoing discussion, Applicants respectfully submit that this application is in condition for allowance with Claims 28-53 as presented herein. Applicants respectfully request the Examiner to withdraw all objections and rejections and to pass this application with allowance with Claims 28-53.

Should the Examiner determine that additional issues may be resolved by a telephone call, the Examiner is cordially invited to contact the undersigned attorney of record so that such issues may be promptly resolved so that this application may be passed to issuance.

Respectfully submitted,

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Dated: August 23, 2004

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